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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,623

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Philippe Moussou

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04/14/2006

COGNIS CORPORATION
PATENT DEPARTMENT
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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/501,623	Applicant(s) MOUSSOU ET AL.	
	Examiner S. B. McCormick-Ewoldt	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-60 is/are pending in the application.
- 4a) Of the above claim(s) 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-54 and 56-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>July 15, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the species, rice, in the reply filed on February 17, 2006 is acknowledged. The traversal is on the ground(s) that the reference, Miyazaki fails to disclose, teach, suggest or provide motivation to arrive at the claimed invention. This is not found persuasive because a bean extract is fermented with a microorganism, lactobacillus or lactococcus or leuconostoc, and the resulting composition is used in skin preparations. In the response filed February 17, 2006, Applicant did not elect a species as requested for claim 51. Applicant was notified by telephone to elect a species of claim 51 on March 15, 2006. Applicant elected, with traverse, the species lactobacillus, on March 30, 2006.

The requirement is still deemed proper and is therefore made FINAL.

Claim 55 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 17, 2006.

Claims Pending

Claims 41-60 are pending. Applicant has cancelled claims 1-40. Claims 41-54 and 56-60 will be examined on the merits solely in regard to the elected species.

Information Disclosure Statement

The references, Bruchausen and Robert listed on the information disclosure statement filed July 15, 2004 is not considered because there are no English translations or an explanation of the relevance of each reference.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 42-48, 54 and 56-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 42-48, 54 and 56-60 either recite, or depend upon a claim which recites "plant extract". It is deemed that Applicant has not set forth a representative number of examples in order to reasonably verify possession of such a potentially enormous number of extracts.

The MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable that the claims are broad generics, with respect to *all* extracts. The possible variations of extracts are limitless. Although Applicant has disclosed several solvents which could potentially be used for "plant extract" (p. 5-6 of specification) this disclosure is actually a *very few* number in comparison to the enormous, *potentially millions* of types of extracts which could be obtained from plants. The reason for this large amount of permutations is because extraction techniques are often coupled in order to obtain a product; for example

- 1) a water extraction followed by an alcoholic extraction: the product obtained is an extract.

- 2) a supercritical extraction (CO₂) followed by an alcoholic and then a non-polar solvent extraction (e.g., chloroform): the product is an extract.

- 3) a benzene extraction followed by a water extraction and chromatographic separation: the product is an extract.

- 4) a water/chloroform extraction (e.g., in a separatory funnel), followed by collection of the water layer, chromatographic separation and crystallization of an isolate: the product is an extract.

- 5) squeezing the plant to obtain a juice: the product is an extract.

- 6) dipping the plant in an organic solvent to remove the waxy layer: the product is an extract.

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The MPEP states that the purpose of the written description requirement is to ensure that the invention had possession, as of the filing date of the application, of the specific subject matter later claimed by him or her. The courts have stated:

“To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F. 3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F. 2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus, an Applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, no that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F. 3d at 1572, 41 USPQ2d at 1966. *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398. The specification lacks sufficient variety of species of extracts to reflect this variance in the genus since the specification does not provide sufficient examples of such a genus of extracts.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F. 2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does “little more than outline [goals] appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.”) Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of “extract” and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the entire scope of the claimed invention and thus, this rejection is proper.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41, 43-44, 49-51, 54 and 57, 59-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Fodor (US 5,653,984).

Fodor *et al.* (US 5,653,984) expressly teach using plant extract from seeds and fermenting the extract by inoculating with a microorganism lactobacilli (i.e. lactobacillus). The temperature is carried out from 34° to 40° C (column 2, lines 59-67). After the fermentation is complete, the fermentation medium is filtered to remove any particulates (column 4, lines 28-30). The extract to be used is in the amount of .1% to 10% by weight of the composition (column 4, lines 40-45). The extract is used in a cosmetic for the skin (i.e. face, neck, hand or body cleansing) and used in various components for the hair (column 4, lines 63-67; column 5, lines 6-7). The plant extract is obtained from seeds, which contains proteins (column 2, lines 8-11). Thus, the fermentation process taught by Fodor meet the limitations of claim 41 as the process comprises fermentation with a microorganism of plant parts and thus anticipates the claimed invention.

Claims 41-43, 50-51, 57 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawaki *et al.* (JP 2001212445-translation provided).

Sawaki *et al.* (JP 2001212445) expressly teach that rice is used with lactobacillus in a fermentation process to be used in cosmetics for the skin and hair ([0005], [0008],[0009], [0017], [0018]). Thus, the fermentation process taught by JP 20012122445 meet the limitations of claim 41 as rice and lactobacillus is used in a fermentation process and thus anticipates the claimed invention.

Claims 41-43, 45-47 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhang *et al.* (US 6,632,428). Zhang *et al.* (US 6,632,428) expressly teaches a rice fermentation process that uses a pretreatment of sterilization. The pH is adjusted to 3.0 to 5.0 and the mixture is steamed sterilized (121° C). The mixture is then cooled and inoculated with a microorganism. Fermentation of the rice mixture is carried out at a temperature of 15°-35° C (column 7, lines 57-

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63). Thus the fermentation process using a pretreatment of sterilization and thus anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 41-54 and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fodor *et al.* (US 5,653,984) in view of Sawaki *et al.* (JP 2001212445-translation provided) in view of Zhang *et al.* (US 6,632,428).

Fodor *et al.* (US 5,653,984) disclose using plant extract from seeds and fermenting the extract by inoculating with a microorganism, lactobacilli (i.e. lactobacillus) and optionally using a yeast. The temperature is carried out from 34° to 40° C (column 2, lines 59-67). After the fermentation is complete, the fermentation medium is filtered to remove any particulates (column 4, lines 28-30). The extract to be used is in the amount of .1% to 10% by weight of the composition (column 4, lines 40-45). The extract is used in a cosmetic for the skin (i.e. face, neck, hand or body cleansing) and used in various components for the hair (column 4, lines 63-67; column 5, lines 6-7). The plant extract is obtained from seeds, which contains proteins (column 2, lines 8-11).

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Fodor does not disclose wherein rice is used or wherein a pretreatment is used or wherein the fermentation broth pH is 4.5 to 8.8 prior to fermentation or wherein the pretreatment is sterilization or pasteurization or wherein the pretreatment is at a temperature from 60° to 135° C.

Sawaki *et al.* (JP 2001212445) disclose that rice is used with lactobacillus in a fermentation process to be used in cosmetics for the skin and hair ([0005], [0008], [0009], [0017], [0018]).

Zhang *et al.* (US 6,632,428) disclose a rice fermentation process that uses a pretreatment of sterilization. The pH is adjusted to 3.0 to 5.0 and the mixture is steamed sterilized (121° C). The mixture is then cooled and inoculated with a microorganism. Fermentation of the rice mixture is carried out at a temperature of 15°-35° C (column 7, lines 57-63).

One of ordinary skill in the art would have been motivated to ferment rice and inoculate the fermentation with lactobacillus because it was known to be used as a cosmetic for the skin or hair. It was clear from Fodor that one can obtain a plant extract from seeds and ferment the extract by inoculating with a microorganism, lactobacilli (i.e. lactobacillus) and optionally using yeast with a temperature from 34° to 40° C. After the fermentation is complete, the fermentation medium is filtered to remove any particulates. The extract is used in a cosmetic for the skin (i.e. face, neck, hand or body cleansing) and used in various components for the hair. It was further clear from JP 2001212445 that rice can be used with lactobacillus in a fermentation process. It was further clear from Zhang a pretreatment of sterilizing the mixture before inoculating with a microorganism has been done. Therefore, one of ordinary skill in the art would have had a reasonable expectation to inoculate a rice fermentation mixture with lactobacillus and to provide an active component to be used on skin and hair.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

Summary

No claim is allowed.

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Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

PATRICIA LEITH
PRIMARY EXAMINER
